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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,004	02/20/2002	Marcus David McMahan	McMahan	1266

7590 04/21/2003

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EXAMINER

DAVIS, CASSANDRA HOPE

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,004

Applicant(s)

MCMAHAN, MARCUS DAVID

Examiner

Cassandra Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9, 11, 12 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 7, 10 and 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

and

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-6, 8, 9, 11, 12, 14-16, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Bailey, U. S. Patent 6,464,507. Bailey teaches a magnetic coaching board comprising a flexible planar magnetic base sheet 10 and plurality of pieces 20 magnetically adhered to the base sheet. The base sheet is in the shape of basketball court with court/field graphic screen-printed thereon and the pieces are in the shape of a ball with a player's number or name painted or printed thereon.
3. With respect to claims 2-3, Bailey teaches the board is a flexible vinyl magnetic sheet. (See column 2, lines 14-15).
4. With respect to claim 5-6, Bailey teaches the magnetic sheet may be painted or marked with the marking of a sports court field such as basketball, baseball, lacrosse, etc. The examiner considers the outline of the playing field to correspond to the claimed

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ornamental shape and the particulars of the field such as the three-point line to correspond to the ornamental image . (See column2, lines 4-5 and column 4, line 4-6).

5. With respect to claims 8 and 11, Bailey teaches that each piece 20 is painted or ink screened a preferential color with a player number or name on the player piece. The examiner considers the number or name to correspond to the claimed "name and/or image of an item".

With respect to claims 9, 12, and 16, since Bailey teaches that the number and name are painted or printed onto the pieces, it is inherent that the paint or ink used to form the number or name is raised above the surface of the piece.

6. Claims 1-6, 11, 9, 12, 14, 15, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Holtz, U. S. Patent 3,93,919. Holtz teaches a magnetic board comprising a flexible or rigid planar magnetic base sheet (figure 3) and plurality of pieces 19, 20 magnetically adhered to the base sheet. The base sheet is in the shape of game board screen-printed thereon and the game pieces having a picture or pattern thereon.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraynd, U. S. Patent 4,817,320 in view of Holtz, U. S. Patent 3,093,919.

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9. Fraynd teaches a shopping reminder system comprising a base 12 having means to attached it to a support surface and plurality of indicator elements 38, 40, 42, 44, 46, 48, and 50 having magnetic member 60 on the rear surface for removable attached to the base 12. Some indicator elements have pictorial representation of a product such as fish 36. Some of the indicator elements are three dimensional such as eggs 50.

Allowable Subject Matter

10. Claims 19 and 20 are allowed.

11. Claims 7, 10, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone number is 703-308-2223. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



Cassandra Davis
Primary Examiner
Art Unit 3611

CD
April 16, 2003